

REMARKS

The Examiner is thanked for conducting a personal interview with Applicant's representative on September 11, 2008 and for acknowledging the claims as amended in the Response filed May 27, 2008 distinguish over cited prior art to Russo (US 6,025,868).

Reconsideration of the pending application is respectfully requested on the basis of the following particulars:

1. Amendments and Support for Same

By this Amendment, claims 1, 2, 4, 43, and 44 have been amended to further clarify the claimed features of the present invention. Support for the amended feature can be found in, e.g., page 7, lines 15-29 of the original specification. No matter has been added.

2. Rejections under 35 U.S.C. §103(a)

With respect to the rejection of claims 1-25, 27-30, 36-41 and 43-44 under 35 U.S.C. §103(a) as obvious over Russo in view of Dunn (U.S. 5,945,987), to the rejection of claim 26 under 35 U.S.C. §103(a) as being unpatentable over Russo and Hoffert (US 6,370,543) in view of Yurt (U.S. 5,132,992), and to the rejection of claims 31-35 and 42 under 35 U.S.C. §103(a) as being unpatentable over Russo and Hoffert, Applicant respectfully traverses the rejection at least for the reason that Russo, Dunn, Hoffert, and Yurt, combined or separately, fail to teach, disclose, or suggest all of the limitation recited in the rejected claims.

Initially, Applicant respectfully notes that Dunn is cited as a secondary reference in combination with Russo in the rejection of claims 1-25, 27-30, 36-41 and 43-44. However, the Office Action does not appear to discuss Dunn at all. Instead of Dunn, Hoffert is mainly discussed and applied as providing cures of Russo's deficiencies. Accordingly, as it not clear how Dunn is applied by the Examiner, Applicant regards the citation of Dunn in the Office Action as a typographical error, and the rejection of claims 1-25, 27-30, 36-41 and 43-44 is considered as being rejected over Russo and Hoffert. Further, Applicant respectfully requests

the Examiner to clarify whether or not Dunn is pertinent to the rejection of claims 1-25, 27-30, 36-41 and 43-44, and if so, reissue a new Office Action with detail discussion of how Dunn is applicable for the record.

As amended claim 1 further clarifies that the storage control portion judges whether or not each content is a pay-per-view content when each content is received, and controls the restoring part to select portions from the received content that are predetermined as previewable and to create a preview when the content is judged as a pay-per-view content. The storage control further selectively stores preview of a pre-viewable pay-per-view content selected from the transmitted content in the storage part.

According to the invention as recited in amended claim 1, pay-per-view contents is clipped as a preview when each transmitted content is received. Consequently, an advantage of the present invention is that users immediately can watch a preview of any pre-viewable pay-per-view contents which will be transmitted on predetermined time in near future without download or accessing server.

Russo, on the other hand, generally describes a pay-per-view system comprising a "receiving part" for receiving a content being transmitted (i.e., tuner 104, Fig. 2), a "storage part" for storing contents (i.e., storage 110, Fig. 2), a "control part" (i.e., central controller 150, Fig. 2). However, Russo describes only recording of the whole program without recording partial contents selectively, which is read out from transmitted pay-per-view contents as recited in claim 1 of Applicant's claimed invention.

At this juncture, Applicant respectfully reminds the Examiner of his acknowledgement during the interview conducted on September 11, 2008, as shown in the Interview Summary, that the claimed invention distinguishes over Russo. More specifically, the Examiner acknowledges that Russo does not teach, disclose, or suggest creating a preview as recited in Applicant's claimed invention.

Without fully repeating the arguments presented during the Examiner interview and in the Response filed May 27, 2008, all of previously submitted arguments in the Response of May 27, 2008 are incorporated herein by reference.

Further, Applicant respectfully requests the Examiner to review and consider the following previously discussed points A)-C):

A) Russo generally describes a device and method for a pay-per-play program. It is an object of Russo to allow a stored program to be substantially viewed before payment is

considered as due so that a view is not limited to contiguous viewing. According to Russo, payment will preferably come due once the majority or some percentage of the program has been watched.

Col. 5, lines 33-40 of Russo states the following:

Alternatively, payment may be transferred or ear-marked to the provider once a program is selected for viewing, but if viewing were to be terminated shortly thereafter and never resumed, the system might automatically re-credit the subscriber for that program, since it was largely unwatched. Such a scheme is in keeping with allowing a viewer to enjoy a free **"preview"** of a program, as described elsewhere herein. [Emphasis added]

Accordingly, Russo discloses only recording of the whole program but does not disclose recording only partial contents selectively, such as to create a preview when the content is judged as a pay-per-view content, as recited in Applicant's claim 1.

B) Russo consistently uses the terminology "preview" in quotations so as to indicate that the "preview" of Russo is has a specific meaning in accordance with the spirit of Russo's invention, which is to not charge for viewing of a program unless it is substantially viewed. That is, according to Russo, partially viewed program is considered as a "preview" and is, therefore, not charged. Taking the meaning of "preview" in proper context of the invention of Russo, the "preview" of Russo does not indicate a conventional meaning of a preview (e.g., trailer) that is well known in the art or the preview in accordance with Applicant's claimed invention, which includes portions selected from a transmitted program (i.e., content) and which are selectively stored as a preview.

C) Russo discloses only that the whole program is stored, and a "preview" means that a viewer unable to view the program substantially entirely and, therefore, is not charged. Further, the "preview information" of Russo means just the position of a viewed portion of a whole program. As Russo does not have the ability to selectively storing portions of the transmitted program as a preview, Russo cannot control which portions of a program a user may not view, such as, for example, mature content, answers in a quiz show, etc.

In view of the above, Applicant respectfully submits that the Examiner's contention that Russo suggest the desirability of a preview function that allows users to preview content without incurring a charge is inconsistent with the Examiner's previous acknowledgment that

Applicant's invention distinguishes over Russo. Further, contrary to the Examiner's allegation, Russo fails to suggest the desirability of a preview function, because the meaning of "preview" of Russo does not meet the preview as precisely defined in Applicant's claim 1 of the present invention.

With respect to the newly cited Hoffert, which allegedly cures Russo's deficiency of a "sophisticate meta data and preview creation", Hoffert generally describes a method and apparatus for searching for multimedia files in a distributed database and for displaying results of the search based on the context and content of the multimedia files. That is, Hoffert relates to an apparatus for generating index from multimedia files. As shown in Fig. 4c of Hoffert, Hoffert's index generating apparatus stores a preview of an examined media object which is read out from searched multimedia contents and has predetermined characteristics. Hoffert's display of media previews is, therefore, applicable to showing samples of analyzed contents of multimedia information found from a search engine, for example, which is different from Applicant's claimed invention that includes judging whether or not a received content is a pay-per-view content and selectively create a preview from contents that are determined as previewable when the received content is judged as a pay-per-view content, as recited in Applicant's pending claims.

Further, Applicant respectfully asserts that Hoffert only describes an apparatus for recording a preview from searched multimedia files, which are accessible (by downloading or streaming) at any time. Therefore, the "preview" of Hoffert is also very different from Applicant's presently claimed invention that creates a preview from transmitted contents of a pay-per-view program which are not accessible (downloading or streaming) at any time.

Applicant respectfully submits that it would not be obvious to combine Russo and Hoffert because Russo and Hoffert are of different and unrelated art, wherein an apparatus of Hoffert used for generating index by searching multimedia files, while an apparatus of Russo used for watching transmitted program, which does not teach, disclose, or suggest previewing as defined in Applicant's claimed invention.

As discussed above, one of the advantages of the presently claimed invention that it is possible for user to determine whether the program, which may be aired on predetermined time in near future should be watched or not without accessing contents again. This advantage is neither achievable by Russo or Hoffert.

With respect to Yurt and the rejection of dependent claim 26, the arguments and amendments discussed above in relation to claim 1 and Russo and Hoffert are also applicable.

That is, similar to Russo and Hoffert, Yurt also fails to teach, disclose, or suggest at least a storage control portion for judging whether or not each content is a pay-per-view content when each content is received, and for controlling the restoring part to select portions from the content received that are predetermined as previewable and to create a preview when the content is judged as a pay-per-view content, and for selectively storing preview of a previewable pay-per-view content selected from the transmitted content in the storage part, in combination with other claimed features, as recited in amended claim 1.

The requirements for establishing a *prima facie* case of obviousness, as detailed in MPEP § 2143 - 2143.03 (pages 2100-122 - 2100-136), are: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the teachings; second, there must be a reasonable expectation of success; and, finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations.

Further, according to MPEP §2141(I), Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

Moreover, according to MPEP §2141(II), when applying 35 U.S.C. §103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

As Russo, Hoffert, and Yurt, combined or separately, fails to teach, disclose, or suggest all of the features of amended claim 1, as well as its dependent claims, the obviousness rejections are improper and should be withdrawn.

In view the amendments and argument set forth above, Applicant respectfully requests the Examiner to follow tenets A-D in combining Russo, Hoffert, and Yurt.

4. Conclusion

In view of the amendments to the claims, and in further view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is requested that claims 1-2, 4-13, 15-26, and 29-44 be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicant's representative, the Examiner is invited to contact the undersigned at the numbers shown.

Further, while no fees are believed to be due, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-4525.

Respectfully submitted,

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